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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* PETER PARKS and JOHN VAN BOXTEL

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Appeal 2009-006978  
Application 10/774,934  
Technology Center 2400

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Before JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and  
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

## STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-27 and 29-36, which are all the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

### *Invention*

Appellants' invention relates to a method for client-side auto-rediscovery for networked devices. The method includes discovering a connection to a service providing networked device, client-side associating the connection, validating the connection before initiating a service request to the service providing networked device, selectively rediscovering the service providing networked device, and selectively client-side reassociating the connection. Abstract.

### *Representative Claim*

1. A client-side auto-rediscovery system, comprising:
  - a data store configured to store a pairing data that relates a service requesting networked device and a service providing networked device; and
  - a logic configured to determine whether the pairing data should be updated and to selectively update the pairing data.

### *Examiner's Rejections*

Claims 1-7, 12, 13, 15-27, 29, and 31-36 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Roy (US 2002/0062366 A1).

Claims 10, 14, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Roy and Wu (US 5,185,860).

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Roy, Wu, and Moetteli (US 2002/0049809 A1).

Claims 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Roy, Wu, and Janz (US 2002/0103888 A1).

### *Claim Groupings*

In view of Appellants' arguments in the Appeal Brief, we will decide the appeal on the basis of claims 1, 10, 12, 13, 30, and 31. *See* 37 C.F.R. § 41.37(c)(1)(vii).

### PRINCIPAL ISSUE

Have Appellants shown that Roy does not describe “logic configured to determine whether the pairing data should be updated and to selectively update the pairing data” as recited in claim 1?

### FINDINGS OF FACT

We rely on the findings of fact made by the Examiner in the Final Rejection and the Examiner's Answer.

### PRINCIPLES OF LAW

#### *Claim Interpretation*

During examination, claims are to be given their broadest reasonable interpretation consistent with the specification, and the language should be read in light of the specification as it would be interpreted by one of ordinary

skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (citations omitted). The Office must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. *Id.* (citations omitted).

## ANALYSIS

### *Section 102 rejection of claims 1-7 and Section 103 rejection of claims 8 and 9*

The Examiner finds that Roy describes logic to determine when a user desires to update addresses of network devices, and then proceeds with the update, which corresponds to “logic configured to determine whether the pairing data should be updated and to selectively update the pairing data.” Final Rejection 13; Ans. 13. Appellants respond that the logic described by Roy must be initiated by a user. According to Appellant, the system of claim 1 may be initiated by factors unrelated to user input. App. Br. 13. The Examiner finds that the term “factors unrelated to user input” is not recited in claim 1. The Examiner further finds that the term “client-side auto-rediscovery system” recited in the preamble is not entitled to patentable weight. According to the Examiner, giving weight to this term still does not specify what the client-side is, or what steps are automatic. Ans. 13. Appellants respond that Roy does not disclose logic “to selectively update the pairing data.” Reply Br. 3-4.

We agree with the Examiner. Appellants have not provided evidence or persuasive argument to show that the scope of “logic to determine whether pairing should be updated” excludes logic to determine when a user desires to update as described by Roy. Further, Appellants have not shown

that the logic of Roy requires any involvement of a user when performing the process of network device location. Appellants have also not provided evidence or persuasive argument to show that the term “client-side auto-rediscovery system” recited in the preamble is entitled to patentable weight. Nor have Appellants explained how giving weight to “client-side auto-rediscovery system” might distinguish claim 1 over the system of Roy. Further, Appellants’ arguments regarding logic “to selectively update the pairing data” were presented for the first time in the Reply Brief, and are untimely. *See Ex parte Borden*, 93 USPQ2d 1473 (BPAI 2010) (informative).

We sustain the rejection of claim 1 under 35 U.S.C. § 102. Claims 2-7 fall with claim 1. Claims 8 and 9 are rejected under 35 U.S.C. § 103. Appellants have not presented arguments for separate patentability of claims 8 and 9, but instead rely on the arguments presented for claim 1. Therefore, we sustain the rejection of claims 8 and 9 under 35 U.S.C. § 103.

*Section 102 rejection of claim 12*

Appellants contend that Roy does not disclose “means for selectively performing automatic strong discovery to rediscover the service providing networked device based on the weak discovery and selectively updating the pairing data based on the strong discovery” as recited in claim 12. In particular, Appellants contend that Roy does nothing concerning updating pairing data, and that the terms “weak discovery” and “strong discovery” are defined in paragraph 32 of the Specification and also in claim 10. Appellants conclude that Roy does not describe “weak discovery” and “strong discovery” as defined by Appellants’ Specification and claim 10,

and therefore cannot describe the “means for selectively performing automatic strong discovery” as recited in claim 12. App. Br. 15-16; Reply Br. 4.

The Examiner finds that Figure 7 of Roy shows data indicating pairing data between printer names and the network addresses that a requesting device can use to reach the printers. The Examiner further finds that the Specification only gives examples of what “weak discovery” and “strong discovery” may include, but does not provide an explicit definition of these terms. The Examiner finds that claim 10 does not define or use the terms “weak discovery” and “strong discovery” that appear in claim 12. The Examiner concludes that Roy describes “means for selectively performing automatic strong discovery to rediscover the service providing networked device based on the weak discovery and selectively updating the pairing data based on the strong discovery” within the meaning of claim 12. Ans. 14-15.

We agree with the Examiner. Appellants have not provided evidence or persuasive argument to rebut the Examiner’s finding that Roy describes updating pairing data within the meaning of claim 12. Further, Appellants have not provided a definition of “weak discovery” and “strong discovery” in the Specification or in claim 12 that precludes the Examiner’s interpretation of these terms. We sustain the rejection of claim 12 under 35 U.S.C. § 102.

*Section 102 rejection of claims 13, 15-27 and 29 and section 103 rejection of claim 14*

Appellants contend that the difference between claim 13 and Roy is that claim 13 performs automatically initiated strong rediscovery while Roy

performs human initiated weak discovery. App. Br. 16-17. However, Appellants have not shown that claim 13 requires “automatically initiated strong rediscovery,” nor have Appellants shown how this term might distinguish claim 13 from Roy.

Appellants also contend that the “determining” recited in claim 13 is defined in the Specification as performed by logic such as hardware, software, or firmware, but not a user as described by Roy. App. Br. 16-17. However, the Specification does not exclude logic that performs “determining” in response to a user’s input. Appellants have not provided evidence or persuasive argument to show that the scope of “determining whether to perform a process” excludes logic that determines when a user desires to update as disclosed by Roy (Ans. 13).

Appellants also contend that Roy does not describe “selectively updating a pairing data that relates the first networked device and the second networked device based, at least in part, on the binding data.” Reply Br. 5. These arguments were presented for the first time in the Reply Brief, and are untimely.

We sustain the rejection of claim 13 under 35 U.S.C. § 102. Claims 14-27 and 29 fall with claim 13.

*Section 102 rejection of claims 31-36*

Appellants contend that claim 31 describes directly re-discovering and reconnecting to previously known devices on its own, without a user-initiated request to do so. App. Br. 18. The Examiner finds that “without a user initiated request” is not recited in claim 31. Ans. 16. Appellants further contend that the claim describes a rediscovery method that is automatically



performed when a first device wants a second device to perform a service. App. Br. 18. According to Appellants, Roy does not make any updates to a table unless a request is manually initiated by a user. App. Br. 19.

We agree with the Examiner. Appellants have not provided evidence or persuasive argument to show that the scope of claim 31 excludes a user initiated request for rediscovery. Appellants have also not provided evidence or persuasive argument to show that user input is required during the performance of the method described by Roy. We sustain the rejection of claim 31 under 35 U.S.C. § 102. Claims 32-36 fall with claim 31.

*Section 103 rejection of claims 10 and 11*

Appellants contend that neither Roy nor Wu describe systems where all elements of the system reside in the requesting device. App. Br. 21. The Examiner finds that Roy teaches a device that contains a “data store,” a “first logic,” and a “second logic” within the meaning of claim 10. Ans. 17. Appellants have not addressed the Examiner’s finding. Appellants also argue that the combination does not teach a strong discovery, weak discovery sequence. App. Br. 20-21. The Examiner finds that claim 10 does not recite strong discovery or weak discovery. Ans. 14-15. Appellants also contend that determining requires logic, which is not taught by the combination of Roy and Wu. App. Br. 21.

We agree with the Examiner. We sustain the rejection of claim 10 under 35 U.S.C. § 103. Claim 11 falls with claim 10.

*Section 103 rejection of claim 30*

Appellants contend that the combination of Roy and Wu does not teach client side rediscovery on a per service request basis. The Examiner finds that the scope of claim 30 encompasses a first networked device performing the process on behalf of itself as taught by Roy. Ans. 17. Appellants have not addressed the Examiner's finding. Appellants also argue that the combination does not teach "selectively updating an IP address, MAC address pair stored on the first networked device." App. Br. 22; Reply Br. 5. Specifically, Appellants contend that Roy performs a method in response to user input, but claim 30 performs functions without user driven input. App. Br. 22. We find the argument about "user input" to be unpersuasive, for reasons previously discussed. We sustain the rejection of claim 30 under 35 U.S.C. § 103.

CONCLUSION OF LAW

Appellants have not shown that Roy fails to describe "logic configured to determine whether the pairing data should be updated and to selectively update the pairing data" as recited in claim 1.

DECISION

The rejection of claims 1-7, 12, 13, 15-27, 29, and 31-36 under 35 U.S.C. § 102(b) as being anticipated by Roy is affirmed.

The rejection of claims 10, 14, and 30 under 35 U.S.C. § 103(a) as being unpatentable over Roy and Wu is affirmed.

The rejection of claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Roy, Wu, and Moetteli is affirmed.

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The rejection of claims 8 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Roy, Wu, and Janz is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED

msc

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